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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,353	01/23/2004	Randy Hoffman	200311332-2	7102
22879	7590	09/08/2009		
HEWLETT-PACKARD COMPANY Intellectual Property Administration 3404 E. Harmony Road Mail Stop 35 FORT COLLINS, CO 80528			EXAMINER MONDT, JOHANNES P	
			ART UNIT 3663	PAPER NUMBER
			NOTIFICATION DATE 09/08/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte:* RANDY HOFFMAN, HAI CHIANG,  
and JOHN WAGER

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Application No. 10/763,353  
Technology Center 3600

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Mailed: September 9, 2009

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Before TINA D. LEE, *Supervisory Paralegal Specialist*

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on August 24, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matters requiring attention prior to docketing.

AMENDMENT AFTER NOTICE OF APPEAL

A review of the file indicates that on October 28, 2008, Appellants filed an Amendment After Notice of Appeal in response to the Final Rejection mailed June 2, 2008. It is not clear whether this Amendment has been considered because an Advisory Action has not been mailed or because box 7 of an Advisory Action fails to indicate whether or not the proposed amendment will or will not be entered for purposes of appeal. Clarification from the Examiner is required.

APPEAL BRIEF, STATUS OF AMENDMENTS

A review of the file finds that the status of the amendments as provided in the Appeal Brief filed January 27, 2009, under the heading “Status of Amendments” is unclear and/or is not consistent with the last entered amendment of record in accordance with 37 C.F.R. 41.37(c)(1)(iv).

A review of the file finds that an After Notice of Appeal Amendment was filed October 28, 2008. An Advisory Action was not mailed notifying Appellants that the After Notice of Appeal Amendment was or was not entered. However, Appellants have not provided the necessary statement as to the status of the After Notice of Appeal Amendment filed October 28, 2008 and/or the statement regarding the status of the amendment is unclear or incorrect. Correction of the status of amendment(s) filed subsequent to Final rejection is required.

APPEAL BRIEF, CLAIMS APPENDIX

A review of the Appeal Brief filed January 27, 2009, reveals that claims in the Claims appendix of the Appeal Brief are not consistent as

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amended in the last entered amendment filed on February 26, 2008. The copy of the claims should be in proper format and should not include any markings such as brackets or underlining except for claims in a reissue application in accordance with 37 C.F.R. 41.37(c)(1)(viii). Furthermore, the Claims Appendix cannot assume entry of After Final Submissions for which an Advisory Action (or other Office communication) has not advised of entry. *See also Manual of Patent Examining Procedure (MPEP) § 1205.02* (8<sup>th</sup> ed. Rev. 6, Sept 2007) for details.

Specifically, claims 31-34, as provided in the Brief's Claims Appendix, read: "The thin-film transistor of claim 60 [[1]], where . . . ."

Appropriate correction of all claims provided in the Claims Appendix in proper format is required.

#### EXAMINER'S ANSWER, HEADINGS

A review of the file indicates that the Examiner's Answer filed May 15, 2009, does not comply with the guidelines provided in MPEP § 1207.02 because it does not contain all of the required heading items. Specifically, the Examiner's Answer must contain the following heading items in the following order:

- (1) *Real party in interest.*
- (2) *Related appeals and interferences.*
- (3) *Status of claims.*
- (4) *Status of amendments After Final.*
- (5) *Summary of claimed subject matter.*
- (6) *Grounds of rejection to be reviewed on appeal.*
- (7) *Claims Appendix.*

(8) *Evidence Relied Upon.*

(9) *Grounds of Rejection.*

(10) *Response to Argument.*

(11) *Related Proceedings Appendix.*

An in-depth review of the Examiner's Answer indicates that the following sections are missing from the Examiner's Answer mailed May 15, 2009, and/or are not complete or clear in setting forth agreement or disagreement with the Appeal Brief:

(4) *Status of amendments After Final.*

A substitute Examiner's Answer that is in compliance with the guidelines is required. *See also Manual of Patent Examining Procedure* (MPEP) § 1207.02 (8<sup>th</sup> ed. Rev. 6, Sept 2007) for details.

### CONCLUSION

Accordingly, it is ORDERED that the application is returned to the Examiner to:

- 1) appropriately respond to the Amendment After Notice of Appeal;
- 2) hold the Appeal Brief filed on January 27, 2009, defective;
- 3) notify Appellants to correct the Claims Appendix of the Brief filed January 27, 2009;
- 4) vacate the Examiner's Answer mailed May 15, 2009;
- 5) provide a new Examiner's Answer including a correct "Status of Amendment" section in addition to correction to other sections as required; and
- 6) for such further action as may be appropriate.

Application No. 10/190,945

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

tdl/babc

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